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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,056	01/10/2006	Hiroyuki Okada	396.45772X00	5663

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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1765

MAIL DATE	DELIVERY MODE
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06/03/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/564,056

Applicant(s)

OKADA ET AL.

Examiner

MARGARET MOORE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 7, 11 to 14, 16 to 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 11 to 14, 16 to 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following rejections are maintained from the previous office action.
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2, 4, 5, 7, 11 to 14 and 16 to 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 02/083763 (as interpreted by Tamura et al.) in view of Fuchs, Ishikawa et al., Roberson or Lammerting for reasons of record.

The rationale for this rejection was detailed in previous office actions and as such will not be repeated.

4. Claims 1, 2, 4, 5, 7, 11 to 14 and 16 to 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dohi in view of WO 02/083763 (as interpreted by Tamura et al.), further in view of Fuchs, Ishikawa et al., Roberson or Lammerting for reasons of record.

The rationale for this rejection was detailed in previous office actions and as such will not be repeated.

5. Applicants' RCE filed 8/23/10 submitted the same claims and arguments that were filed in the after final response dated 7/23/10. At that time the Examiner indicated that the amended claims would not overcome the rejections noted supra. The Examiner will reiterate the reasons provided by in the Advisory Action.

Applicants' lengthy arguments simply are not persuasive of an unobvious difference between the composition rendered obvious by Tamura et al. in view of the 4 secondary references of record. These arguments do not appear to raise any new issues but rather rehash those that have already been presented, namely the term "coating film" and the wetting properties. With regard to the narrowed compounds (A)

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and (B) in the claims, please note that Tamura et al. teach both of these compounds, even in combination (Ex. 6). This is not sufficient to overcome the rejections.

Applicants' still argue that "coating" gives life and meaning to the claims but again, claim 1 does not require a substrate and thus this term alone, or even with the phrase "capable of being formed on a substrate" (which is simply a future intended use) does not lend unobviousness to the claims over the prior art. The Examiner again emphasizes her position that the film of claim 1 can be free standing. For the claims that do require a substrate the Examiner has already noted that the film in Tamura et al. is applied to a glass or metal mold. At the least see column 28, line 44 and on. This meets the surface, for instance, in claim 7. Again, regarding the wetting property, the Examiner has addressed this both in the previous office action and in the action dated 7/2/2009. The prior art need not be combined for the same reason as applicants to render a composition obvious.

With regard to new claim 24 note that this combination of components is found in Examples 6 and 13 to 28.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARGARET MOORE whose telephone number is (571)272-1090. The examiner can normally be reached on Monday, Wednesday and Friday, 9 am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Margaret G. Moore/
Primary Examiner, Art Unit 1765

mgm
5/26/11